

REMARKS

Claims 12,13, 15, 16, 18, 19, 21, and 22 are pending in this application. Claims 12 and 13 have been amended to more clearly define the subject matter. It is respectfully submitted that no new issue that would require further consideration and/or search by the Examiner is raised by the foregoing amendments. Therefore, it is respectfully submitted that entry of these amendments is proper after final rejection, and entry thereof is respectfully requested.

Foreign Priority

Applicants request that the Examiner acknowledge applicants' claims for foreign priority and the receipt of certified copies of the priority documents.

Claims Rejected Under Japan Patent Publication No. 11-246399 (Keita)

Claims 12, 15, 18, and 21 were rejected as being inherently anticipated by JP Patent Pub. No. 11-246399 (Keita). Applicants respectfully traverse these rejections.

The discovery of a new use for an old structure based on unknown properties of the structure may be patentable. *See* MPEP 21102.02. The patent statutes define "process" to include "a new use of a known process, machine, manufacture, composition of matter, or material."¹ For example, a new use of an old drug (minoxidil for treating hair loss, where it was previously used for blood pressure), is patentable.² Furthermore, in the new use of an old drug, the intended treatment is relevant. For example, in a method reciting the intent of "treating or preventing macrocytic-megaloblastic anemia" by administering a known composition "to a human in need thereof [referring to treatment]," the intended treatment is relevant to claim construction.³

Keita discloses the administration of a curcumin composition to regulate lipid metabolism resulting in the reduction of triglyceride levels. *Keita* indicates that this regulation

1 35 U.S.C. §100(b).

2 *Upjohn Co. v. Medtron Lab.*, 894 F. Supp. 126 (S.D.N.Y. 1995) (affirmed without opinion, 937 F.2d 622 (Fed. Cir. 1991)).

3 *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329 (Fed. Cir. 2003).

occurs by enhancement of acyl-CoA oxidase activity.

In the present application, claim 12 is directed to a method of lowering blood pressure by the use of curcumin or curcuminoid compositions, wherein claim 12 is now amended to recite the additional limitation that the subject of the method is one “desired for the lowering of blood glucose level,” and the composition is administered “with the intention of lowering blood glucose level in said subject.”

Keita is directed to the regulation of lipid metabolism and makes no mention of the lowering of blood glucose. It is known that glucose metabolism and lipid metabolism occur through separate metabolic pathways.

Claim 12 is thus directed to a new use of curcumin compositions based on previously unknown properties. Furthermore, the intended new use (lowering blood glucose in subjects) is relevant to patentability. For at least these reasons, Applicants respectfully submit that *Keita* does not inherently anticipate claim 12.

Claims Rejected Under WO 99/22728

Claims 13, 16, 19, and 22 were rejected as being inherently anticipated by WO 99/22728 (Liao). Applicants respectfully traverse these rejections. Claim 13 is directed to a method of reducing visceral fat by the use of curcumin and curcuminoid compositions, wherein claim 13 is now amended to recite the additional limitation that the subject of the method is one “desired for the reduction of visceral fat,” and the composition is administered “with the intention of reducing visceral fat in said subject.”

The Federal Circuit court has stated: “[a]n invitation to investigate is not an inherent disclosure” where a prior art reference “discloses no more than a broad genus of potential applications of its discoveries.”⁴

Liao describes numerous compounds (more than 100 listed in Tables 1-7) with various potential applications, including the treatment of prostate cancer, breast cancer, skin cancer,

4 In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999).

baldness, skin disorders, benign prostatic hypertrophy (BPH), and female hirsutism, as well as weight loss (see p. 7).

Liao does not specify which of the numerous compounds listed are to be used for the various applications. With respect to organ and body weight loss, *Liao* simply states that “[a] compound of this invention can be used to decrease organ and body weight” (see p. 12). Also, it makes no mention of whether body weight is decreased by the reduction of fluid mass, muscle mass, bone mass, or adipose mass. Furthermore, with respect to adipose mass, it makes no mention of whether subcutaneous fat, or abdominal visceral fat, or both are involved. Specifically, *Liao* does not mention that curcumin could be used to reduce visceral fat.

At most, *Liao* is simply an invitation to investigate the use of its numerous compounds (more than 100 in total) for the various potential applications. It does not inherently disclose the use of curcumin or curcuminoid compositions for the reduction of visceral fat as recited in claim 13. For at least these reasons, Applicants respectfully submit that *Liao* does not inherently anticipate claim 13.

CONCLUSION

Applicants respectfully submit that the present application is now in condition for allowance. The Examiner is invited to contact Applicants' representative to discuss any issue that would expedite allowance of this application.

No extensions of time or other fees are required in connection with the filing of this response. However, in case the filing of this paper is deemed not timely, Applicants petition for an appropriate extension of time. The Commissioner is authorized to charge all required fees, fees under § 1.17, or all required extension of time fees, or to credit any overpayment to Kenyon & Kenyon's Deposit Account No. 11-0600.

Respectfully submitted,

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